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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

UBILES, MARIE C

ART UNIT	PAPER NUMBER
2642	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,794

Applicant(s)

PERNU ET AL.

Examiner

Marie C. Ubiles

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant claims that the information is transmitted "in a suitable information element". The previously identified term renders the limitation vague and indefinite, as the term encompass a broad range of materials and/or equipment used for information transmission.

Claims 8, 12, 17 and 34 recites the limitation "the telecommunication terminal" in line 2. Claim 9 recites the limitations "A-party" and "B-party telecommunication terminal" in line 2. Claim 10 recites the limitations "A-party" in line 2, and "B-party telecommunication terminal" in lines 2 and 4. Claim 11 recites the limitations "A-party" in line 3, and "B-party telecommunication terminal" in lines 2 and 4. Claim 18 recites the limitation "the telecommunication terminal" in line 6. There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2642

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1, 3, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Gore et al. (US 5,313,463).

As for claim 1 and 18, Gore et al. discloses a method for implementing a service in a digital-service network or ISDN (See Detailed Description, Col. 3, lines 29-31) comprising an exchange or telecommunications network (See Figure 2, element 200), a first telecommunication terminal or one of a plurality of user terminals connected to the multiple-service network via a first interface (See Detailed Description, Col. 3, lines 35-40) and a second telecommunication or ISDN terminal (See Figure 2, element 310) connected to the multiple-service network via a second interface (See Figure 2, element 16), wherein the service or credit check is implemented using a server or credit-checking database (See Figure 2, element 280) connected to the multiple-service network via a third interface or path (See Figure 2, element 21), and the service or credit-check information is transmitted to the second telecommunication or ISDN terminal using channels reserved for signaling (or D-channel) and a signaling protocol comprising a limited amount of information not belonging to the call (See Detailed Description, Col. 4, lines 36-42).

As for claim 3 and 20, Gore et al. further discloses a trunk facility (See Figure 2, element 14) for transmission of the service information.

Claim Rejections - 35 USC § 103

Art Unit: 2642

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 4, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Wrede et al. (US 5,937,040).

Gore et al. disclose the invention as claimed except for the receipt of the service information in the form of a text message and the information being transmitted using UUS signaling. Wred et al. teaches a method in which a message is transmitted simultaneously as speech over a B-channel and as text file over the signaling or D-channel (See Summary of the Invention, Col. 2, lines 46-51). Wrede et al. further teaches "The conversion of the messages formats the information for the visual presentation at the display of the remote phone terminal. [...] referring to the ISDN environment, the formatting may be achieved by embedding the menu information into

Art Unit: 2642

DISPLAY Information Elements (IEs) or into containers (i.e., envelopes) of user-to-user information compatible with D-channel transmission, so that digital character strings are sent for display in realtime at a remote ISDN display phone." (See Summary of the Invention, Col. 2, lines 44-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gore et al. method by transmitting the text file or service information using user-to-user signaling as taught by Wrede et al., so a user at a telecommunication terminal or remote ISDN display phone can read the service information from the terminal's display screen.

4. Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al (US. 5,313,463) in view of ETSI (European Telecommunications Standard Institute) (Draft prETS 300 716: February 1996).

Gore et al. disclose the invention as claimed except for the service information being transmitted using USBS signaling. ETSI teaches "The USBS provides the unrestricted transfer (without alteration) of user information, on the D-channel of user access, in a packetized manner over a virtual circuit between reference points via the basic and primary rate access." (See Scope, page 7, lines 13-15).

It is well known in the art that in a virtual circuit, when a user wishes to transmit information, he or she simply transmit the information (as no conventional dialing is needed), thus no setup and no disconnect operations are needed when data or service information is sent. It would have been obvious to one of ordinary skill in the art at the

Art Unit: 2642

time the invention was made, to modify Gore et al. method by transmitting the user or service information using USBS signaling as taught by the ETSI draft paper, providing the user the ability to transfer the aforementioned service information over a virtual circuit and therefore making possible for the information to be transferred to the telecommunications terminal in a rapid and cost-effective manner.

5. Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of ETSI (European Telecommunications Standard Institute) (ETS 300 050: October 1991).

Gore et al. disclose the invention as claimed except for the server distinguishing the service to be provided via multiple subscriber numbering (MSN) and a number of terminal-specific identification numbers have been defined for the basic subscriber interface.

ETSI teaches "The Multiple Subscriber Number (MSN) supplementary service provides the possibility for assigning multiple numbers to a single public or private access. This allows e.g.: 1) a calling user to select, via the public network, one or multiple distinct terminals out of a multiple choice; 2) to identify the terminal to the network for the application of other supplementary services." (See Scope, page 7, lines 14-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by distinctly identifying each telecommunications terminal via MSN as taught by the ETSI paper, so that the service

information (or other supplementary services) requested by said terminal arrives to the terminal where the request is originated from (this reads on "to identify the terminal to the network for the application of other supplementary services").

6. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Newton (Newton's Telecom Dictionary, March 1998). Gore et al. disclose the invention as claimed except for the server distinguishing the service to be provided via subaddressing.

Newton teaches "[subaddressing] a name for an ISDN service which enables many different type of terminals [...] to be connected to the ISDN user interface and uniquely identified during a call request." (See Newton's Telecom Dictionary, March 1998, page 683).

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Gore et al. method by distinctly identifying each telecommunications terminal via subaddressing as taught by Newton, so that the service information (or other supplementary services) requested by said terminal arrives to the terminal where the request is originated from (this reads on "[terminal] uniquely identified during a call request").

7. Claims 8-11, 13-16 and 25-28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Boivie et al. (US 4,633,041).

Gore et al. disclose the invention as claimed except for the service information stored in the server or database and transmitted from the exchange into the second telecommunication terminal or B-party; being telephone book information related to a first telecommunication terminal or A-party.

Boivie et al. teaches "Alternatively, automatic directory assistance can be provided locally at the station set using a microcomputer having the capacity to store several hundred directory entries.[...] A microprocessor accumulates the inputs and displays the name and assigned telephone number upon matching the inputted entries with one of the records stored in memory. A problem arises since it is quite expensive to provide such equipment at each station set. Moreover, it would be almost as expensive to provide an alphanumeric keyboard at each station for the purpose of providing centralized automatic directory assistance. [...]The invention obviates the problems associated with the prior art by providing a response to each entry, as it is inputted by a station set user using the station set keypad. As each digital coded letter of a sought-after name is entered, it is added to a sequence of previously inputted entries. Each newly formed sequence is then compared with the leading substring of characters contained in each record of a stored directory. When a match is found, the information field (containing the sought-after name and telephone number) of the matching record is returned to the user. Thus, in most instances, the sought-after name and telephone number are returned to the user prior to the user inputting all of the digit encoded letters of the name being input." (See Background of the Invention,

Col. 1, lines 12-15, 19-27 & Summary of the Invention, Col. 1, lines 65-68 and Col. 2, lines 1-10).

Boivie et al. further teaches "Control is distributed among a plurality of system ports 200-1 through 200-N, with each system port, such as systems port 200-1, serving a number of terminals, such as station S1.[...] Interface 101 is used to interface call processor 103 to system bus A and bus B.[...] Briefly, the system shown handles voice signals, as well as data, between the various stations. Tone source signal detector 102 detects digit tones inputting by a station set, such as station set S1. Processor 103 provides control information to the system ports indicative of the time slots assigned to a particular station. Associated with call processor 103 is memory 104 in which is stored the program which directs the operation of the system. Memory 104 also contain records associated with each station, such as station S1. Stimuli, such as digit tones and supervisory signals, received from station S1 are stored in its assigned station record. The station record is used by processor 103, operating in conjunction with the stored program, to track the functional status of station S1 upon receiving a new stimulus therefrom." (See System Overview, Col. 2, lines 47-50, 56-57, 61-68 and Col. 3, lines 1-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Gore et al. method by making the service information stored in the server or database and transmitted from the exchange into the second telecommunication terminal or B-party (or station 1 S1); being telephone book information (or stored directory) related to a first telecommunication terminal or A-party

(or one of a plurality of system ports 200-1) as taught by Boivie et al; thus avoiding the use of extra equipment at each telecommunication terminal so that the user can access telephone book information related to another telecommunications terminal.

Regarding claims 10-11, 14-15, 27-28 and 31-32, the examiner takes official notice that facility or information message transmission between a terminal/application and ISDN drivers is inherent of an ISDN network.

8. Claims 12, 17, 29 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Gore et al. (US 5,313,463) in view of Boivie et al. (US 4,633,041) as applied to claims 8-11 and 13-16 above, and further in view of Masuda (4,709,387).

Masuda teaches A telephone having a memory for storing telephone numbers and proper names related to each telephone number, and input means for introducing said telephone numbers and proper names into said memory, an improvement in said input comprising: keyboard means including a plurality of keys consisting only of numeric keys and function keys; display means for displaying information input by said keys; said memory having stored therein alphabetic character data capable of generating all characters of an alphabet from which said proper names shall be formed..." (See Claim 1, lines 28-40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the aforementioned method by providing a telecommunications terminal with capabilities for storing telephone numbers or

Art Unit: 2642

telephone book information within memory of said terminal, therefore the user will not have to request the exchange/server to provide service information related to telephone book information that is used constantly-used by said user and that this information is readily access by said user.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Clark et al. (US 5,490,251) teaches in the presently preferred embodiment, such a "user-user information element" contains non-conventional data to be utilized by the calling and/or called stations. Such stations employ application programs which utilize the data within the "user-user "information element". Such data is transmitted over the D channel of the ISDN. Accordingly, there is no need to establish communication over the B channel since the non-conventional data which would have conventionally been transmitted over the B channel may be transmitted over the D channel as part of the information element of the "user-user information element." (See Detailed Description of the Drawings, Col. 9, lines 56-67).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone numbers

Art Unit: 2642

for the organization where this application or proceeding is assigned are (703) 305-7201 for regular communications and (703) 305-7201 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Marie C. Ubiles
November 3, 2003


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TECHNOLOGY CENTER 2600

Application/Control Number: 09/867,794

Art Unit: 2642

Page 13